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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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07/09/2001

Kazunori Suzuki

SAT 163

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7590

11/15/2007

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3694

MAIL DATE

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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/899,818	Applicant(s) SUZUKI ET AL.	
	Examiner Daniel S. Felten	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/28/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-14,17,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-14,17,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt of the amendment filed August 28, 2007 is acknowledged. Claims 1, 4, 15, 16 & 18-21 have been cancelled. Claims 2, 3, 5-14, 17 are currently amended and claims 22 and 23 are new. Thus claims 2, 3, 5-14, 17, 22 and 23 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. The claims remain rejected using Kerkdijk in view of Vazvan (WO 97/45814). The applicant asserts that the primary reference Kerkdijk does not teach the redirection section limitation. The applicant respectfully reminded that prior art is not read in a vacuum, but for what they suggest to one of ordinary skill in the art. The redirection section, in this case, receives information from the user terminal and transfers it to a shop server. It is submitted that Kerkdijk suggests a redirection section of information from a user (or customer) to a shop server (or a merchant) in his invention (see column 3, lines 61+). Moreover Kerkidjk suggests a content converting section disclosed in as much a summarized information is provided to the customer upon completion of a transaction (see column 4, lines 5+).

Specification

3. The amendment filed August 28, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

supported by the original disclosure is as follows: "It is not the user terminal 10 that transfers the payment information to the wallet server."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation wherein the user terminal has no function of transferring said payment information to said wallet server is not described in the applicant's specification, or at least describe in such a way as to convey support from the specification [see MPEP 2173.05(i)].

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 8-14 and 17 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The structure which goes to make up the relay server device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a

complete operative relay server device. The applicant in claim 22, limitation recites a relay server for use in a payment system/e-commerce system, but then provides features not consistent with the features of the relay server 40 (figs. 1 & 2) (see applicant's specification, page 11, lines 13-22; and page 13, lines 17 to page 18, line 14), but more applicable to the e-commerce system 100 for which the relay server is a component of (see fig. 1, page 11, lines 13-22; and page 13, lines 17 to page 18, line 14). Claims 2, 3, 8-14 and 17 are recite features that are not a part of the relay server or its functionality as disclosed in the applicant's specification (see figs. 1 & 2), but are claimed as a part of the e-commerce system as a whole (i.e., in claims 2, 3 & 23, the user terminal).

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation or "A relay server for use in a payment system that includes a user terminal able to be connected to a network and during a payment procedure...a shop server connected to a network...a payment

server connected to a network...a wallet server...” and the claim also recites “wherein said relay server comprises a redirecting section...” which is the narrower statement of the range/limitation. Also it seems that the applicant is claiming the e-commerce system 100, or the entire system (see fig. 1), instead of claiming features disclosed in applicant’s specification concerning the relay server 40 (see figs. 1 & 2). Thus the much broader limitation of the e-commerce system and then the more narrow claim language of the relay server found in the second limitation makes claim 1 indefinite.

6. In claim 4, “a converting unit to select at least one predetermined information item out of said information for said payment procedure *based on a receiving capability of said user terminal*, to produce summarized information using at least one selected information item...” is indefinite because the phrase, “said payment procedure *based on a receiving capability* of the user terminal” does not convey that the converting unit in the limitation is required to select at least one predetermined information item but only has the potential of performing this function.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 5-14, 17, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkdijk in view of Vazvan (WO 97/45814).

Kerkdijk discloses a relay server 11 (Agent Negotiation Server, "ANS") for use in a payment system (see fig. 1) that includes a user terminal 2 (customer PC) able to be connected to a network 1 (Internet) and used during a payment procedure for a transaction on the network between a shop (merchant) and a user (customer) using a user terminal (see Kerkdijk, column 2, lines 22-25; and column 2 line 62 to column 3, line 27), a shop server 3 (merchant servers) connected to the network and used to produce payment information including an amount to be paid by said user in said transaction (see column 2, lines 22-25), a payment server 5 connected to the network and used to perform payment processing for said transaction between said user and said shop (see Kerkdijk, column 2, lines 26+), and a wallet server 9 (Third party Server) connected to said network and having authentication information of said user required for said payment server for said payment processing (see column 2, lines 38+),

Wherein the relay server 14 comprising redirecting section which receives from said user terminal procedure requesting information to prompt said shop to take said payment procedure and transfers said procedure requesting information to said shop server (see column 2, line 47 to column 3, line 27),

and which receives said payment information from shop server and transfers said payment information to the wallet server (see column 2, line 47 to column 3, line 27; and column 3, line 62 to column 4, line 7).

a redirecting section that receives first information from the user terminal and transfers the first information to the shop server, the first information including procedure requesting information that prompts the shop server to undertake the payment procedure, the redirection section additionally receiving second information from the shop server and transferring the

second information to the wallet server, the second information including payment information (see column 3, lines 64+); and

a contents converting section that receives third information from the wallet server, selects at least one predetermined information item out of the third information to produce summarized information, and transmits the summarized information to the user terminal, the third information including information about the payment processing procedure (see column 4, lines 1-10)

the user terminal has a predetermined user capability, and the summarized information that is produced by the contents converting section is based on the receiving capability of the user terminal (see column 4, lines 1-10)

Kerkdijk fails to disclose that the user terminal comprises a portable cellular phone. Vazan discloses a remote purchase payment system that uses a wireless/cellular terminal that allows a user to perform remote purchases and bill payment transactions over a network (see Vazan, fig. 1, Abstract, and page 4, line 21 to page 6, line 8). It would have been obvious for an artisan at the time of the invention of Kerkdijk to substitute the Mobile Wallet-Phone ("MWP") in Vazan for the customer terminal 2 because an artisan would have considered the MWP as an art recognized equivalent to the customer terminal inasmuch as both are used to perform transactions via a network. An artisan would be motivated to substitute the MWP for the customer terminal so as to conveniently allow the customer to complete and/or conduct transactions/exchanges remotely without having to be in a stationary location. Thus the ability to physically conduct secure transactions in any location over a multimedia network without

being tied to a stationary computer/terminal would provide greater accessibility to the Kerkdijk system and thus would be an obvious expedient well within the ordinary skill of the art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

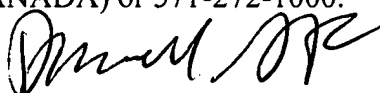
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten
Examiner
Art Unit 3694

DSF
11/12/2007